

REMARKS

In the Office Action dated April 30, 2002, the Examiner rejected claims 33, 38-40 and 60 under 35 U.S.C. § 102, and rejected claims 34-37, 41, 42, 91-99, 117, 118, 120 and 121 under 35 U.S.C. 103(a). The Examiner also objected to the drawings on the basis of the cross-hatching and for failure to show the drive shaft.

With respect to the drawings, Applicant has submitted amended drawings with cross-hatching. It is requested that the objection be withdrawn. With respect to the drive shaft, Applicant submits that the drive shaft is shown as item 71 shown in FIG. 16. It is important to note that the drive shaft is not affirmatively claimed in the claims. Therefore, Applicant submits that the drive shaft need not be shown in the drawings.

With respect to the rejections based on the prior art, Applicant respectfully traverses the rejections. The Office Action rejects claims 33, 38-40 and 60 under 35 U.S.C. 102(b) as being anticipated by Otto (Patent Number 5,707,222). Before addressing the specific anticipation rejections, applicant would like to clarify what is required for a claim to be anticipated. As stated by the Federal Circuit:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984).

The Office Action rejects claim 33 as being anticipated by Otto. Claim 33 requires “the rotor . . . being formed as one piece.” While the Examiner suggests that Otto teaches a one-piece rotor, Applicant’s view of Otto is substantially different. Otto recites that “[t]he drive element 13

is located between the two identical half bodies 9 and 11 of the rotor 7.” (Col. 3, lines 50-51).

Furthermore, Otto notes: “Torque introduced into the coupling section 23 is transmitted to the rotor 7 since the drive element 13 is firmly clamped between the half bodies 9 and 11, **which are connected to each other**, for instance, **by a bolt 37** which passes through the drive element.”

(Col. 3, lines 57-61). If Otto taught a one-piece rotor, there would be no need to bolt the two half bodies together. Thus Applicant respectfully traverses the rejection and submits the claim is neither anticipated nor rendered obvious by Otto.

Applicant has amended claim 33 to clarify the verb tense for comprises, but has not changed the scope thereof.

Claims 38-40 and 60 are dependent on claim 33. With the anticipation rejection of claim 33 withdrawn, claims 38-40 and 60 are also not anticipated by Otto and should be allowed.

Claims 34-37, 41, 42, 91-99, 117, 118, 120 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto in view of Hattori et al. (Publication Number 61-149594).

Before addressing the specific obviousness rejection, Applicant wishes to clarify what is required to support an obviousness rejection. The Office Action must establish a prima facie case of obviousness to meet the burden of § 103.

The PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

Id. At 1600. Rather, “[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Applicant submits that the Office Action does not make a prima facie case of obviousness in that it does not show either (a) some objective teaching in the prior art that suggests combining the references, or (b) knowledge generally available to one of ordinary skill in the art which would lead that individual to combine the relevant teachings of the references to achieve the invention claimed, or c) that the combined inventions would result in the claimed invention. See In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). With the above background in mind, the rejection under 35 U.S.C. § 103 will be discussed.

As noted above, Otto does not teach the elements of claim 33, in that it does not teach a one-piece rotor as set forth in the claim. The Examiner has failed to point out any teaching in the additional art which would suggest that the two patents be combined. Furthermore, since Otto does not teach all of the elements of claim 33, the addition of Hattori et al. fails to achieve the invention set forth in claims 34-37, 41 and 42, which are all dependent on claim 33 or are dependent on claims that are dependent on claim 33. Therefore, Applicant traverses the rejection as to each of these claims.

Claim 91 is rejected as obvious due to the teachings in Otto in light of the teachings in Hattori et al. Otto is held to teach all of the requirements of claim 91 excluding the cavities which Hattori is held to teach. As noted above, however, Otto teaches bolting the two identical half bodies together, thereby leading anyone skilled in the art to understand that the rotor is

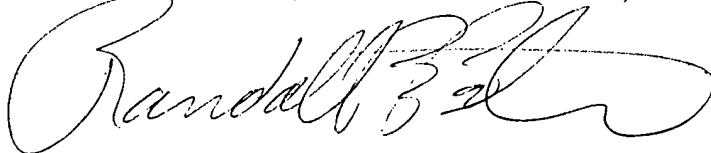
formed of at least two pieces. This being so, Otto combined with Hattori cannot be said to render the claim obvious and Applicant respectfully requests that the obviousness rejection of claim 91 be withdrawn.

Claims 92-99, 117, 118, 120 and 121 are all either dependent on claim 91 or on other claims that are themselves dependent on claim 91. With the withdrawal of the obviousness rejection of claim 91, all obviousness rejections of the dependent claims should also be withdrawn.

Claims 1 through 32 have been canceled and claims 33 through 122 substituted therefore. Applicant respectfully submits that the application is in condition for allowance. Should the Examiner determine that there is a need for adverse action on the claims, it is requested that he contact Applicant's attorney, Randall B. Bateman at (801) 478-0071 so that such matters may be resolved as expeditiously as possible.

Respectfully Submitted,

MORRISS, BATEMAN, O'BRYANT & COMPAGNI, PC

A handwritten signature in black ink, appearing to read "Randall B. Bateman", with a stylized flourish at the end.

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